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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,852	12/04/2003	Norikazu Niimi	782_124 DIV2	7921
25191	7590	06/29/2004	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			PERRY, ANTHONY T	
			ART UNIT	PAPER NUMBER
			2879	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/727,852

Applicant(s)

NIIMI, NORIKAZU

Examiner

Anthony T Perry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 17-20 and 22 is/are rejected.
- 7) ☐ Claim(s) 1-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/631419.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/04/03
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

Claims 1-32 are objected to because of minor informalities.

Regarding claims 1-16, in line 12 of claim 1, change "main phase" to --a main phase--.

Regarding claims 1-16, in line 16 of claim 1, change "comprising ceramic phase" to --comprising a ceramic phase--.

Regarding claims 17-32, in lines 8-9 of claim 17, change "main phase" to --a main phase--.

Regarding claims 17-32, in line 13 of claim 17, change "comprising ceramic phase" to --comprising a ceramic phase--.

Appropriate correction is required.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6, 17-20, and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4 of U.S. Patent No.

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6,642,654. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons.

U.S. Application SN 10/727852	U.S. Patent No. 6,642,654	Reasons for rejection under obviousness-type double patenting
Claims 1 and 17	Claim 1	Patent '654 claims a high pressure discharge lamp comprising: a ceramic discharge tube with an inner space formed therein and end portions, said inner space being filled with an ionizable light-emitting material and a starter gas and an opening being formed within said end portion; an electrode system provided within said inner space; a sealing member comprising a ceramic or a cermet with a through hole formed therein, at least a part of said sealing member being fixed within said opening of said ceramic discharge tube; and a metal member, wherein said lamp comprises a joining portion interposed between said metal member and said sealing member, and said joining portion comprises a main phase contacting said metal member and an intermediate ceramic layer contacting said sealing member and existing between said sealing member and said main phase, said main phase comprising a porous bone structure with open pores and made of a sintered product of powder of a metal, and said main phase further comprising a ceramic phase impregnated into said open pores in said porous bone structure. Claims 1 and 17 of the current application are considered to be obvious variants of the invention claimed in Patent '654 since all of the limitations are claimed in claim 1 of the US Patent.
Claims 2, 4, and 20	Claim 4	Patent '654 claims that the intermediate ceramic layer and the impregnated ceramic phase contain a main component of the ceramic of the discharge tube. One of ordinary skill in the art would have found it obvious to have the sealing member and discharge tube made of the same material so that the thermal expansion coefficients match maintaining the integrity of the electrode system and the seal between the electrode system and the discharge tube.
Claims 3 and 19	Claim 1	Patent '654 remains silent with regards to the metal of the metal member and the porous bone structure. However, one of ordinary skill

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		in the art would have found it obvious to have the metal member and the porous bone structure containing the same main component of metal so that the thermal expansion coefficients closely match maintaining the integrity of the electrode system and the seal between the electrode system and the discharge tube.
Claims 6 and 22	Claim 1	Patent '654 claims the device, wherein the impregnated ceramic phase has a crystallinity of more than 50% which encompasses the range claimed in the current application.
Claim 18	Claim 4	Patent '654 claims that the intermediate ceramic layer and the impregnated ceramic phase contain a main component of the ceramic of the discharge tube.

***Allowable Subject Matter***

Claims 5, 7-16, 21, and 23-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Anthony Perry* whose telephone number is (571) 272-2459. The examiner can normally be reached between the hours of 9:00AM to 5:30PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel, can be reached on (571) 272-24597. **The fax phone number for this Group is (703) 872-9306.**

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Anthony.perry@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



Anthony Perry  
Patent Examiner  
Art Unit 2879  
June 23, 2004



Vip Patel  
Primary Examiner  
Art Unit 2879